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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91160810
Party	Plaintiff The Mentholatum Company
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

THE MENTHOLATUM COMPANY,

Opposer,

v.

THEROX, INC.,

Applicant.

Opposition No.: 91/160,810

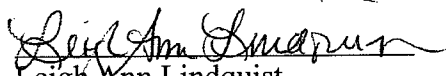
REPLY BRIEF OF OPPOSER

Opposer respectfully resubmits its Reply Brief dated May 18, 2007.

Opposer's counsel recently checked the TTABVUE and noticed that Opposer's Reply Brief of May 2007 has not been scanned into the TTABVUE system. Accordingly, Opposer herewith submits a copy of its Reply Brief along with its certificate of service and stamped filing receipt for such Reply Brief.

Opposer respectfully requests that its Reply Brief be made an official part of the record and be scanned into TTABVUE.

Respectfully submitted,


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Date: December 4, 2007

CERTIFICATE OF SERVICE

I, Kecia Lash, an employee of Sughrue Mion, PLLC hereby certify that on this 4th day of December, 2007, a true and correct copy of the foregoing **RESUBMISSION OF THE REPLY BRIEF OF OPPOSER** has been properly served, via First Class U.S. Mail, postage prepaid to:

Tawnya R. Wojciechowski, Esq.
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Kecia Lash

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REPLY BRIEF OF OPPOSER

I. INTRODUCTION

Applicant has filed a response to Opposer Trial Brief and attempted to show there is no likelihood of confusion between Opposer's OXY marks and Applicant's applied for OXIUM mark. Applicant ignores the fact that the goods listed in its application are broadly identified skincare preparations.

There are no limitations on trade channels, classes of purchasers, or price points in the opposed application. Applicant argues that its mark is used on an "exclusive" product but the identification of goods in the application is not so limited. All of Applicant's arguments are based on the false premise that the identification of goods in its application is very narrowly identified. However, the goods are not narrowly identified, and even if they were more narrowly identified, confusion between Applicant's OXIUM mark and Opposer's OXY mark would be likely.

II. ARGUMENT

A. *OXY and OXIUM Are Confusingly Similar.*

Applicant claims that Opposer dissects Applicant's OXIUM mark. This is not the case. Rather, it is Opposer's position that the marks, compared in their entireties, are substantially the same in sound, appearance and connotation.¹

¹ Applicant states that Opposer does not use its mark in any manner that would create a family of marks. Applicant's Brief at page 7. Opposer did not plead and has not argued that it has a family of OXY marks.

1. The Marks Are Similar In Appearance.

It simply defies logic to claim that OXY and OXIUM are not similar in appearance. The applied for mark in Serial No. 78/116,976 is OXIUM without stylization or color. That mark may be presented in any font, format or color.

2. The Similarities In Sound Are Undeniable.

Applicant contends that OXY and OXIUM are different in sound. In support of this argument, Applicant cites to Truescents v. Ride Skin Care, LLC, 81 U.S.P.Q.2d 1334 (T.T.A.B. 2006) where the Board compared GENUINE RIDE SKIN CARE & design to GENUINE SKIN. In that case, the Applicant disclaimed the wording GENUINE SKIN CARE and the Board found the dominant portion of the mark to be RIDE which was in the middle of the design mark and in much larger letters than the other wording. With respect to the sound comparison, the Board noted that GENUINE and SKIN are separated by RIDE, and GENUINE RIDE SKIN CARE and GENUINE SKIN were not similar in sound. Truescents, 81 U.S.P.Q.2d at 1341. This is completely different from the situation here.

Applicant's mark, as Applicant concedes, consists of three syllables: OX - I - UM. Opposer's marks have two syllables: OX -Y. The marks are very similar to one another in sound. The Board has found similarity in sound in comparable cases. See Centraz Industries Inc. v. Spartan Chemical Co., 77 U.S.P.Q.2d 1698, 1701 (T.T.A.B. 2006) (ICE SHINE vs ISHINE); Alfacell Corp. v. Anticancer Inc., 71 U.S.P.Q.2d 1301, 1305 (T.T.A.B. 2004) (ONCASE vs ONCONASE); In re Infinity Broadcasting Corp. of Dallas, 60 U.S.P.Q.2d 1214, 1217 (T.T.A.B. 2001) (KYNG vs KING-TV and KING-FM).

Applicant further attempts to distinguish the marks by describing how the marks would be pronounced and what stress one would give each syllable. As Applicant is well aware, there is no correct way to pronounce a mark. Centraz, 77 U.S.P.Q.2d 1698, 1701 (T.T.A.B. 2006) (“There is no correct pronunciation of a trademark, and it obviously is not possible for a trademark owner to control how purchasers will vocalize its mark.”) (citations omitted). This argument, therefore, is baseless.

3. There is No Prescribed Meaning for Either Parties’ Mark.

Applicant states that Opposer’s mark is “descriptive of [the] benzoin peroxide content.” Applicant’s Brief, pp. 8, 22. Aside from the fact that such a descriptiveness argument is an impermissible collateral attack on Opposer’s pleaded registrations which may not be considered in the absence of a counterclaim to cancel said registrations, there is simply no basis for such an argument in the evidentiary record in this case. Opposer’s mark has no known prescribed meaning.

Applicant also argues that the marks create different commercial impressions because of how they are used on the parties’ respective products. Applicant presents Opposer’s packaging and Applicant’s packaging on page 9 of its brief to permit the Board to make a side-by-side comparison.² This is not the proper test for likelihood of confusion. Miss Universe L.P. v. Community Marketing Inc., 82 U.S.P.Q.2d 1562, 1570 (T.T.A.B. 2007) (“The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-

² Applicant claims to reproduce Opposer’s products as represented in Exhibit 3 of the Cantrell Deposition on page 9 of Applicant’s brief. Opposer attaches a copy of Exhibit 3 here as Appendix A. The photographs and tagline that appear on page 9 of Applicant’s brief are *not* of record. Opposer requests that the Board ignore these images and refer to Appendix A for how Opposer uses its mark on packaging.

side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks”) (citations omitted). Applicant’s alleged “trade dress” is not at issue in this opposition proceeding. Applicant’s mark as applied for is OXIUM in block letters. The applied for mark is not in a stylized font and does not include a design element or color claim. The mark in Serial No. 78/116,976 is not for packaging but for a word mark. The mark that is the subject of this opposition is OXIUM.

Applicant’s attempts to distinguish the parties’ marks fail. OXY and OXIUM are similar, and this factor strongly favors Opposer.

B. The Goods Identified in the Application Are Related to Opposer’s Good.

There is no requirement that the parties’ goods be identical in a likelihood of confusion analysis. The Board recognizes that:

it is not necessary that the respective goods be identical or even competitive in order to support a finding of likelihood of confusion. That is, the issue is not whether consumers would confuse the goods themselves, but rather whether they would be confused as to the source of the goods. It is sufficient that the goods be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods.

Barbara’s Bakery Inc. v. Landesman, 82 U.S.P.Q.2d 1283, 1286 (T.T.A.B. 2007) (citations omitted) (emphasis added).

The goods in the registration at issue are: Oxygenated skin care preparations, namely, creams, masks, gels and lotions for the face, hands, feet and body, not including acne preparations. These are the goods the Board considers in the likelihood of confusion analysis. See Kohler Co. v. Baldwin Hardware Corp., 82 U.S.P.Q.2d 1100, 1109-1110 (T.T.A.B. 2007). In contrast, the Board is not limited to the goods as recited in Opposer's registrations in a likelihood of confusion analysis but may consider Opposer's use of its marks, its intended use of its marks and the natural zone of expansion of its products. See Mason Engineering and Designing Corp. v. Mateson Chemical Corp., 225 U.S.P.Q. 956, 962 (T.T.A.B. 1985).

Opposer has a real and bona fide intent to use its OXY mark on non-acne treatment products. This is evidenced by the Cantrell testimony deposition and the existence of U.S. Application No. 78/774,055. (Cantrell Dep., - confidential portion p. 50, lns. 2-19, p. 51, lns. 1-23, p. 52, lns. 14-20, p. 53, lns. 1-18). Moreover, the third party registrations of record show what is common in the industry: companies often adopt and register the same mark for both acne products and general cosmetic products and have done so for many years and prior to Applicant's filing date. (Opposer's Notices of Reliance dated October 24, 2006 and February 6, 2007). Opposer's intent to offer non-acne treatment skincare products is a natural expansion of its current anti-acne skincare products.

Applicant's arguments concerning the parties' ingredients, the parties' containers and FDA regulations simply does not change the fact that Opposer's and Applicant's goods are related for purposes of determining likelihood of confusion.

C. The Parties' Trade Channels Are Identical.

Both parties offer or intend to offer skincare products. Opposer offers skincare products for acne treatment. Applicant offers or intends to offer other skincare products not for acne treatment. Accordingly, the parties' goods would be found in the same channels of trade: those for skincare products.

Applicant has not limited its identification of goods to specify that it will only sell anti-aging products through medi-spas and the like. As stated, the goods in the application read: Oxygenated skin care preparations, namely, creams, masks, gels and lotions for the face, hands, feet and body, not including acne preparations. All normal channels of trade for these type of goods, namely, skincare preparations, are presumed.

The evidence of record shows that skincare products, both non-acne treatment and anti-acne treatment products, are sold through the same channels of trade. (Cantrell Dep., p. 22, lns. 15-23, p. 23, lns. 1-3.) In fact, a photograph from the Brown deposition shows Opposer's product one shelf away from an "anti-wrinkle cream". (Brown Dep., p. 27, lns. 24-25, p. 28, lns. 1-12, Ex. 6). Exhibit 6 is reproduced below:



The parties' goods travel in the same channels of trade for purposes of this opposition.

D. Applicant's Purchasers Are Not Sophisticated.

As stated, the goods in the subject application are unrestricted. There is no indication as to what price these goods will be sold at or to whom the products will be sold. Applicant's goods are presumed to encompass expensive and inexpensive skincare preparations. See In re Opus One Inc., 60 U.S.P.Q.2d 1812, 1818 (T.T.A.B. 2001). Applicant pointlessly argues that the parties' goods are sold at different price points.

Applicant also contends that its consumers and Opposer's consumers do not overlap, even though the evidence of record shows that both parties offer their products to women between the ages of thirty-five and fifty-five.³ (Cantrell Dep., p. 18, lns. 5-11; - confidential

³ In a footnote, Applicant insinuates that Mr. Cantrell read Mr. Brown's deposition and that Mr. Cantrell adapted his testimony in response to Mr. Brown's deposition, specifically with respect to Opposer's marketing efforts. Applicant's Brief, p. 17, fn. 12. Exhibit 13 to Mr. Cantrell's deposition

portion Ex. 13 - ; Creech Dep., p. 12, ln. 25, p. 13, lns. 1-14). To support its argument, Applicant lists some of the promotions Opposer has placed for its OXY products.⁴ (Applicant's Brief, pp. 17-19). Aside from the main point that Applicant's application contains no restriction on types of consumers, Applicant ignores the evidence of regard that shows that the parties' consumers, in fact, overlap. (Cantrell Dep., Exs. 6, 8, - confidential portion, Ex. 13 - ; Brown Dep., p. 20, lns. 19-24; Creech Dep., p. 12, ln. 25, p. 13, lns. 1-14). Mothers and grandmothers attend the Dew Action Sports Tour. (Cantrell Dep., Ex. 6). Chaperons have visited the OXY Party Pad. (Cantrell Dep., Ex. 5). Without citing to any part of the record, Applicant takes the position that Opposer's promotions on MTV, MTV2, Comedy Central, and NBC would not be seen by women between the ages of thirty-five and sixty-five. (Applicant's Br., pp. 17-19). Applicant also contends that Opposer's website is directed to women aged thirty-five to sixty-five.⁵

The Cantrell Deposition clearly identifies and describes Opposer's marketing efforts directed to mothers of teenage boys. (Cantrell Dep., p. 18, lns. 5-11, p. 30, lns. 9-22, - confidential portion Ex. 13). Applicant is unable to accept that Opposer markets and intends to market its products to both teenage boys and their mothers. Some of Opposer's marketing efforts are directed exclusively to women between the ages of thirty-five and fifty-five years,

shows that mothers of teenage boys purchase Opposer's products. This study was completed on June 12, 2006, months before Mr. Brown's deposition. Applicant has completely ignored the evidence of record. Moreover, Mr. Brown testified that adults purchased the OXY product. (Brown Dep., p. 20, lns. 19-24).

⁴ It is worth noting that Dave Mirra whom Opposer sponsors is thirty-three years of age; he is not a teenager. (Cantrell Dep., Ex. 5).

⁵ Applicant has once again included information not of record in its brief. On Page 19 of its brief, Applicant has included a screen shot from the opening page at the *oxynation.com* website. Attached as Appendix B is a copy of the first page of Cantrell Exhibit 2 which is the opening page of the *oxynation.com* website that is of record in this case.

others are directed exclusively to teenage boys, and yet others are directed to both women aged thirty-five to fifty-five and teenage boys.

E. Opposer's OXY Mark is Famous and Entitled to a Broad Scope of Protection.

When considering the strength of a mark, the Board examines both the mark's inherent strength and the marketplace strength. Tea Board of India v. Republic of Tea Inc., 80 U.S.P.Q.2d 1881, 1898-1899 (T.T.A.B. 2006). Opposer's mark is inherently distinctive. The mark has been used for over thirty years. Opposer holds incontestable trademark registrations for OXY. OXY is inherently strong.

Marketplace strength is evidenced by sales and advertising figures, surveys, promotions and the like. Opposer has submitted sales and advertising figures for its OXY products which are impressive. Consumers have seen the OXY mark on television, in stores and in promotions for over thirty years. Opposer has sponsored events that provided Opposer and its OXY mark with significant exposure. A brand awareness study is of record. All of this evidence shows the marketplace strength of the OXY mark.

Applicant attempts to argue that Opposer's promotions do not contribute to the overall notoriety and fame of Opposer's mark. Opposer's sponsorships and other promotions are classic examples of how a mark achieves fame. See Volkswagenwerk Aktiengesellschaft v. D & R Sales, Inc., 189 U.S.P.Q. 549 (T.T.A.B. 1975).

Applicant next argues that OXY is a diluted term and references alleged trademark registrations for OXY marks for various products. No registration numbers are provided and none of these alleged registrations is of record. Accordingly, the Board is requested to disregard

Applicant's discussion of third party marks at pages 21-22 of Applicant's Brief. Trademark Trial and Appeal Board Manual of Procedure, § 704.03(b)(1)(B) ("a party may *not* make a third-party registration of record simply ... by referring to the registration in its brief or pleading. The Board does not take judicial notice of registrations in the Office.").

F. The Lack of Actual Confusion of Record Is A Neutral Factor.

Applicant concedes there is no evidence of actual confusion of record but states that this factor weighs in favor of Applicant. However, Applicant only offered its product in a very limited test market. By July 2003, only seven "sites" were part of the test market: four spa/salons, two plastic surgery suites, and one dermatological practice. (Creech Dep., Ex. 4). There were simply no opportunities for confusion to occur.

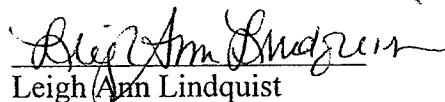
This factor favors neither party.

III. CONCLUSION

The record shows that confusion is likely between OXY and OXIUM for the parties' respective goods. Applicant's improper attempts to narrow its identification of goods, focus on a side-by-side comparison of the marks, and disparage Opposer's products cannot alter the conclusion that the relevant Dupont likelihood of confusion factors favor Opposer.

Opposer respectfully requests that the Opposition be sustained and registration to Applicant be refused.

Respectfully submitted,



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Attorneys for Opposer - The Mentholatum Company

Date: May 18, 2007



Attn: Department 46 Managers

OXY product is driving sales in the Acne category! The combination of great new packaging and great new product has created almost a 40% increase year to date.

To continue this trend, we need your help in making a modular change. Representatives from National In-Store Merchandising will be in stores from April 17th – April 28th 2006 working on behalf of The Mentholatum Co., Inc. (OXY Acne Solutions). During these store visits they will be pulling OXY Standard 90 ct Pads (formerly OXY Sensitive) item #4650656 and with your help preparing product for recall. In place of OXY Standard Pads, representatives working with your help will place OXY Chill Factor Wash tags (item # 4661220). The representatives will also be placing OXY Tinted Lotion (where applicable) item #4650572 for recall and placing tags for OXY Chill Factor Pads (#4661227). **THIS SWAP IS TO BE PERFORMED WHETHER PRODUCT IS IN BLACK PACKAGING OR WHITE PACKAGING.** The Mentholatum Co will provide 100% credit for returned product as well as fund the expense of this return. Please direct any questions to Brian Rola from Mentholatum at the phone number/email below.

Brian Rola
Wal★Mart Account Manager
The Mentholatum Company
(800) 688 – 7660 x1573
Cell (716) 866 - 8128
rola@mentholatum.com

Thank You for your attention to this matter.

Sincerely,

Debra Warner
Buyer Department 46 - skincare



OXY Sensitive 90 Ct
WM #4650656



**DEPOSITION
EXHIBIT**

#3 for ID
10/19/06



OXY Chill Factor Wash
WM #4661220



Appendix H

WHY USE OXY TO HAVE SMOOTH, CLEAR, SKIN?

Why check out the "Support Your Jock" Giveaway from OXY and MTV? Because you could win cool daily prizes like iPods, video games, and maybe even a \$25,000 makeover for your high school's athletic program.

So get in the game. Because if you can't do it twice a day, what good are you?



CLICK HERE
TO
"SUPPORT
YOUR JOCK"



CLICK HERE
TO
VISIT oxynation.com

CLICK ON
MY BELLY
TO REPLAY
THE VIDEO

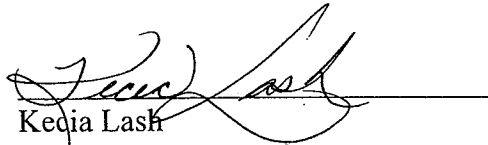
**DEPOSITION
EXHIBIT**

#2 for ID
10/19/06

CERTIFICATE OF SERVICE

I, Kecia Lash, an employee of Sughrue Mion, PLLC hereby certify that on this 18th day of May, 2007, a true and correct copy of the foregoing **REPLY BRIEF OF OPPOSER** has been properly served, via First Class U.S. Mail, postage prepaid to:

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Irvine, CA 92612


Kecia Lash
Sughrue Mion, PLLC

38

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Paper(s) Filed:

1. REPLY BRIEF OF OPPOSER
2. APPENDIX A & B
3. CERTIFICATE OF SERVICE

**DOCKET NO.: 201091
ATTORNEY: LAL/kcl**

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Date: May 18, 2007

